REMARKS

Status of the Application

Claims 1-39 are all the claims pending in the Application. Claims 1-5, 8-16, 19-27 and 30-33 have been rejected. Claims 1, 12 and 23 are amended in a clarifying, non-limiting, manner, as described below.

Allowable Subject Matter

Applicant acknowledges that the Examiner has indicated that claims 6, 7, 17, 18, 28, 29, 35, 37 and 39 would be allowed if rewritten in independent form. However, Applicant declines at this time to draft these claims in independent form since the independent claims should be allowed.

Claim Objection

The Examiner has objected to claims 34-39 under 37 C.F.R. § 1.75 as allegedly being substantial duplicates of claims 1, 6, 12, 17, 23 and 28.

Applicant respectfully submits that the Examiner's position is not reasonable, since he has alleged that the recitation of "a false clause" in claims 34, 36 and 38 is not supported by the instant Application (which Applicant strongly disagrees with), while the recitation of "one or more false clauses" in claim 1, 12 and 23 is supported by the instant Application. In this regard, if the recitations of claims 34-39 are different enough from the recitations of claims 1, 6, 12, 17, 23 and 28 to warrant a written description rejection of claims 34-39, Applicant respectfully submits that the respective claims are surely different enough *vis-à-vis* 37 C.F.R. § 1.75.

In contrast, if the Examiner now believes that the recitations of claims 34-39 are the same as the recitations of claims 1, 6, 12, 17, 23 and 28, the 35 U.S.C. § 112 rejections of claims 34-39 cannot reasonably be maintained, and should immediately be withdrawn.

Written Description Rejection

The Examiner has rejected claims 1, 12, 23 and 34-39 under 35 U.S.C. § 112, first paragraph, as allegedly not complying with the written description requirement.

Regarding claims 1, 12 and 23, the Examiner has indicated that the "step of executing the modified query with the false clause was not described in the specification." Applicant believes that this rejection is based on the successive recitations of "one or more false clauses" and "the false clause" in claims 1, 12 and 23, and therefore amends claims 1, 12 and 23 in a clarifying manner to provide correct antecedent basis.[1] As pointed out in previous actions, this amendment does not change the scope of claims 1, 12 and 23, as both "a false clause" and "one or more false clauses" read on embodiments utilizing a singular false clause or multiple false clauses.

Regarding claims 34-39, the Examiner again alleges that "the step of modifying the query to replace one or more selected clauses with a false clause" was not described in the specification as filed. Applicant again disagrees.

Specifically, Applicant directs the Examiner to page 10, line 26 through page 11, line 15 of the instant Application. This portion of the Application indicates that "[i]f a SQL statement

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[1] Applicant believes that this claim language would have more appropriately been rejected under 35 U.S.C. § 112, second paragraph.

has <u>two WHERE clauses</u>, then <u>one false WHERE clause is generated</u> and used to replace both of

the WHERE clauses" (<u>emphasis</u> added). This portion of the Application clearly supports the

claimed arrangement, as one false clause is generated and used to replace multiple WHERE

clauses.

Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

Obviousness Rejection

The Examiner has rejected claims 1-5, 8-16, 19-27, 30-33, 34, 36 and 38 under 35

U.S.C. § 103(a) as being unpatentable over what the Examiner has alleged to be Applicant's

"*Admitted Prior Art*" (hereinafter "*Related Art*") set forth in the "related art" section of the

Application (pgs. 1-2)[2] in view of "*Fundamentals of Database Systems*" by *Elmasri et al.*

(hereafter "*Elmasri*"). This rejection is respectfully traversed.

The Examiner's Position Regarding Independent Claims 1, 12, 23, 34, 36 and 38

The Examiner alleges that (*Office Action*, par. bridging pages 6 and 7):

(1) the DML (Data Manipulation Language) mentioned in the *Related Art* "is a language

to manipulate a database;"

(2) "SQL is a Data Manipulation Language;"

(3) *Elmasri* indicates that SQL is in the form of "SELECT <attribute list>, FROM

<table list>, WHERE <condition>;"

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[2] Applicant has not admitted that the subject matter described in the section of the specification entitled
"Description of the Related Art" is prior art that falls within the orbit of 35 U.S.C. § 102.

(4) "<condition> is a Boolean (TRUE, FALSE) expression that identifies the tuples to

be retrieved by the query;"

(5) FIG. 7.3(c) of *Elmasri* discloses "the result of query Q12 with column names as

metadata but without any data return, because the condition of the WHERE statement is

FALSE;" and

(6) the "DML statement as disclosed in the admission, obviously, could be altered by

replacing a WHERE statement with a false statement so that it returns no data, but allows full

access to column names as metadata."

The Examiner Has Still Not Established Prima Facie Obviousness

Regarding allegation (5), the Examiner seems to allege that query Q12 shown on page

200 of *Elmasri* discloses the replacement of a WHERE clause with a FALSE clause. This is not

the case. The WHERE clause of Query Q12 is "WHERE ESSN=E.SSN AND

E.FNAME=DEPENDENT_NAME AND SEX=E.SEX)." There is no "false clause" in this

WHERE clause. For an example of such a "false clause," Applicant directs the Examiner to pg.

12, line 23 of the Application ("WHERE 1= -1").

Further, Table 7.3(c) of *Elmasri*, which is cited by the Examiner, shows the result of

Query Q12 applied against the tables of Figure 6.6 (pg. 146). Since no records match the

parameters of Query Q12, no records are returned. However, it is important to note that this is

simply because there are no matching records, not because any of the WHERE clauses in Q12

was replaced by a "false clause."

In fact, there is simply no mention of the use of any "false clause," or the replacement of

a selected clause by a "false clause," in either the *Related Art* or *Elmasri*. The only indication of

the claimed use of a "false clause" as a replacement for a selected clause is provided by the

description of the claimed invention in the instant Application. However, the Examiner is not

permitted to use this description to provide a motivation to modify the DML of the *Related Art*,

as the use thereof is impermissible hindsight. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ

209, 212 (CCPA 1971).

Regarding allegation (6), the Examiner argues that a "DML statement as disclosed in the

admission, obviously, could be altered by replacing a WHERE statement with a false statement,"

(emphasis added). Applicants respectfully submit that whether or not one of ordinary skill in the

art at the time of the invention ("one of skill") "could" have modified the cited references is not

particularly relevant. Rather, the relevant consideration is whether one of skill would have been

motivated to modify the *Related Art* with *Elmasri* in the fashion proposed by the Examiner.[3] In

this case, the Examiner has not identified any particular reason why one of skill would have been

so motivated, instead just concluding that such a modification could have been made.

Thus, Applicant respectfully submits that independent claims 1, 12, 23, 34, 36 and 38 are

patentable over the *Related Art*. Further, Applicant respectfully submits that rejected dependent

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[3] It has long been held that the mere fact that references can be "combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination [or modification]." *In re Mills*, 916 F.2d 680 (Fed.Cir. 1990); MPEP §2143.01.

claims 2-5, 8-11, 13-16, 19-22, 24-27 and 30-33 are allowable, *at least* by virtue of their

dependency.

Thus, Applicant respectfully requests that the Examiner withdraw this rejection.

Conclusion

In view of the foregoing, it is respectfully submitted that claims 1-39 are allowable.

Thus, it is respectfully submitted that the application now is in condition for allowance with all

of the claims 1-39.

If any points remain in issue which the Examiner feels may be best resolved through a

personal or telephone interview, the Examiner is kindly requested to contact the undersigned at

the telephone number listed below.

Please charge any fees which may be required to maintain the pendency of this

application, except for the Issue Fee, to our Deposit Account No. 19-4880.

Respectfully submitted,

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